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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/810,084

03/16/2001

Mark Nelson

NLN 301

7370

7590

01/22/2004

Robert D. Varitz P.C.
2007 S.E. Grant Street
Portland, OR 97214

EXAMINER

JAGAN, MIRELLYS

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,084

Applicant(s)

NELSON ET AL.

Examiner

Mirellys Jagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/20/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claims 20-22, the phrase "-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "- like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,894,677 to Hoffman in view of U.S. Patent 1,860,635 to Thompson and U.S. Patent 6,442,863 to Poineau et al [hereinafter Poineau].

Hoffman discloses a workpiece surface-gripping device that is attachable to the outer end of an elongate generally planar linear measuring tape (746) having a long axis, the device comprising a circular body (756) having a closed planar central body expanse with an outer edge forming a circular perimeter, and a mounting structure (758) joined to the body expanse centrally relative to the perimeter, the mounting structure accommodating a releasable mounting of the

device on the tape at a location adjacent the tape's outer end. Hoffman discloses that the body extends traverse to the lengthwise edge of the tape in order to facilitate orienting the tape and reading the tape indicia when measuring. The body may also be of different shapes (see figures 10 and 11, and column 6, lines 20-34).

Hoffman does not disclose the body being "bottle-cap" shaped by having an elongate, substantially annular continuous perimeter structure formed of a single row of projecting, side-by-side adjacent, teeth projecting normally in one direction from and relative to the body toward the tape and distributed along the full length of the perimeter of the body to substantially circumsurrounding the tape's axis, wherein the teeth are the only workpiece-gripping teeth in the device, and the device including means to 'snap-fit' the tape to the mounting structure wherein the means to 'snap-fit' the tape to the mounting structure projects from the plane of the body expanse in the same direction as do the teeth.

Thompson discloses a planar workpiece surface-gripping body (8) joinable to a measuring tape outer end, the body utilizing a perimeter structure formed of a row of projecting teeth projecting normally in one direction from and relative to the body toward the tape and distributed on and along the edge of the body for contacting and gripping the far surface of a workpiece. Thompson teaches that it is beneficial to place the row of teeth on and along the edge of the body in order to firmly grip an article to be measured to facilitate taking measurements.

Poineau discloses a workpiece surface-gripping device (12) including means (16) to 'snap-fit' the endpiece (11) of a measuring tape to the device, wherein the means to 'snap-fit' the tape projects in a direction extending toward the measuring tape. Poineau teaches that it is beneficial to use means to 'snap-fit' the tape since it allows the tape to be securely attached to the

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workpiece surface-gripping device while taking measurements (see figure 3; and column 3, lines 61-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the body disclosed by Hoffman by adding a row of teeth on and along the edge of the body, as taught by Thompson, in order to grip a workpiece surface more securely while taking measurements.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman by adding means to 'snap-fit' the tape to the mounting structure, as taught by Thompson, in order to more securely attach the tape to the workpiece surface-gripping device while taking measurements.

In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman, Thompson, and Poineau by providing additional teeth such that the teeth extend side by side around the entire perimeter in order to provide more teeth to create a larger gripping surface and more firmly grip an article to be measured, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of Thompson.

Hoffman discloses a workpiece surface-gripping device that is attachable to the outer end of an elongate generally planar linear measuring tape (746) having a long axis, the device

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comprising a circular body (756) having a planar central body expanse with an outer edge forming a circular perimeter, and a mounting structure (758) joined to the body expanse centrally relative to the perimeter, the mounting structure accommodating a releasable mounting of the device on the tape at a location adjacent the tape's outer end. Hoffman discloses that the body extends traverse to the lengthwise edge of the tape in order to facilitate orienting the tape and reading the tape indicia when measuring. The body may also be of different shapes (see figures 10 and 11, and column 6, lines 20-34).

Hoffman does not disclose the body having an elongate, substantially annular continuous perimeter structure formed of a row of plural, spaced, projecting teeth projecting adapted to grip a surface of a workpiece and extending normally in one direction from and relative to the body toward the tape and distributed along the perimeter of the body to substantially circumsurround the tape's axis such that they are on opposite sides of the tape's nominal plane.

Thompson discloses a planar workpiece surface-gripping body (8) joinable to a measuring tape outer end, the body utilizing a perimeter structure formed of a row of projecting teeth projecting normally in one direction from and relative to the body toward the tape and distributed on and along the edge of the body for contacting and gripping the far surface of a workpiece. Thompson teaches that it is beneficial to place the row of teeth on and along the edge of the body in order to firmly grip an article to be measured to facilitate taking measurements.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the body disclosed by Hoffman by adding a row of teeth on and along the edge of the body, as taught by Thompson, in order to grip a workpiece surface more securely while taking measurements.

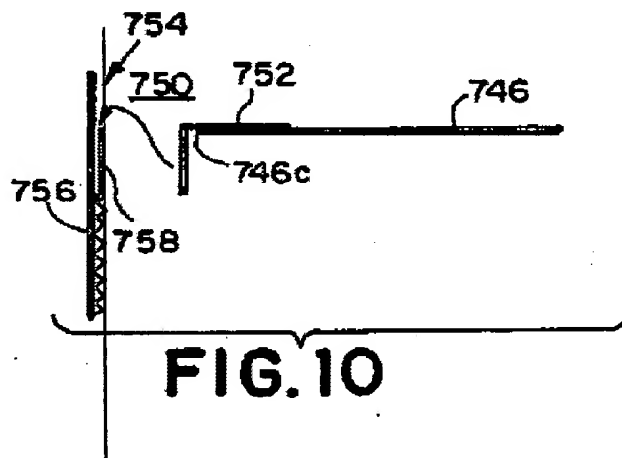
Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman and Thompson by providing additional teeth such that the teeth extend around the entire perimeter in order to provide more teeth to create a larger gripping surface and more firmly grip an article to be measured, and since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. See St. Regis Paper Co. v. Bemis Co., 193

Response to Arguments

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, applicant's arguments that no cited reference shows or suggests a bottle-cap shaped device formed with teeth formed along the rim of the planar body are not persuasive since the rejections are based on combinations of references and not on a single reference.

7. Applicant's arguments that Hoffman warns against the use of teeth on the planar tab in any direction are not persuasive. Applicant relies on the limitation in the independent claim of Hoffman, which states "no tab portions extending beyond said transverse tab portions", as support for the applicant's interpretation that Hoffman is warning that placing teeth on the planar body in a direction toward the tape will destroy the Hoffman reference. These arguments are not persuasive since the limitation "no tab portions extending beyond said transverse tab portions"

relied upon by applicant was added to the claim by Hoffman during prosecution of the case in order to overcome a prior art (U.S. Patent 1,303,756 to Ballou) teaching a prong extending from a planar body in a direction away from the tape. The limitation relied upon by applicant does not preclude a person having ordinary skill in the art from improving the Hoffman device by adding teeth in a direction extending toward the tape to more securely hold the device against a surface when taking measurements. The addition of teeth to the plane of the tab in a direction facing toward the tape will not destroy the Hoffman reference since the operation of the device would not be modified as shown below.



8. Applicant's arguments with respect to a "snap-fit" structure have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following publication discloses an attachment for the end of a measuring tape:

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U.S. Patent Application Publication 2003/0167651 to Pederson

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 703-305-0930. The examiner can normally be reached on Monday-Thursday from 8AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on 703-308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7725 for regular communications and 703-308-7725 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

mj
January 12, 2004



Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800